

### **REMARKS:**

This application has been reviewed in light of the Official Action mailed May 26, 2006 and the Decision of the Board of Patent Appeals and Interferences on August 25, 2009.

Applicant requests that this amendment submitted under 37 CFR § 1.114 along with a Request for Continued Examination (RCE) be entered and the examination of the application be continued. Reconsideration of this application in view of the below remarks is respectfully requested. Amendment filed on September 29, 2006 has been entered. By the present amendment, claims 16, 19, 22, 26, 29, 32, and 36-40 are amended. No new subject matter is introduced into the disclosure by way of the present amendment. Claims 16-40 are pending in the application with claims 16, 19, 22, 26, 29, 32, and 36-39 being in independent form.

#### **Objection**

In the Official Action, the Examiner objected to claim 40 for informalities. The Examiner states that the instruction of the code does not alter. Claim 40 is amended to make the technical meaning more clear. Accordingly, Applicants respectfully request withdrawal of the objection with respect to claim 40.

#### **Rejection under 35 U.S.C. § 102 (b)**

Claims 1, 5, and 9 are rejected under 35 U.S.C. § 102 (b) as being anticipated by Stenman et al. (U.S. Patent No. 6,223,029) (hereinafter "Stenman"). Claims 1, 5, and 9 have been cancelled rendering their rejections moot.

#### **Rejection under 35 U.S.C. § 103 (a)**

Claims 2-3, 6-7, and 10-11 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Stenman in view of O'Donnell et al. (U.S. Patent No. 5,414, 426) (hereinafter "O'Donnell"). Claims 2-3, 6-7, and 10-11 have been cancelled rendering their rejections moot.

Claims 4, 8, and 12-13 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Stenman in view of Wall et al. (U.S. Patent Publication No. 2003/0156053) (hereinafter “Wall”). Claims 4, 8, and 12-13 have been cancelled rendering their rejections moot.

Claims 14 and 15 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Stenman and Wall in view of O'Donnell and further in view of Goldstein (U.S. Patent No. 5,410,326) (hereinafter “Goldstein”). Claims 14 and 15 have been cancelled rendering their rejections moot.

Claims 16, 19, 22, 26, 29, 32, and 36-38 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Stenman and in view of Shim (U.S. Patent No. 6, 078, 270) (hereinafter “Shim”). Claims 16, 19, 22, 26, 29, 32, and 36-38, each of which is an independent claim, are amended to recite “storage means for storing a group of remote control codes for only one predetermined controlling operation to be performed on the target equipment”. Support for this amendment can be found throughout the specification, for example, on page 26, line 1 and page 27, line 2. Further, claims 19, 22, 26, 29, 32, 36-38 are amended to recite “a code definition unit including a number of codes showing at least whether the remote control codes are predetermined and fixed or variable and assigned by a user”. Support for this amendment can be found on page 28, lines 2-7, page 29, line 14, page 30, line 8, and Figure 16.

Regarding the recitation of the first amendment, this recitation limits a predetermined controlling operation to only one predetermined controlling operation. Shim teaches two operations. In the first operation, a user operates a key matrix 20 that directs outputting a single instruction data set from a remote controller IC 10 buffer, and transmitting the selected single instruction data set using LED. In the other operation, a user operates another key matrix 20 key to direct outputting plural instruction data sets from a remote controller IC 10 buffer, and

transmitting the selected plural instruction data sets using the LED. (See column 3, lines 42-63, and column 4, lines 12-29). Shim teaches 1) a single code for controlling a single function, and 2) multiple codes for controlling multiple operations, each for controlling one operation. By contrast, the claimed invention includes multiple codes for only one operation, which distinguishes from Shim. However, this feature, i.e., only one, is not sufficiently described in the claims according to the Board. The Board states that “a predetermined controlling operation” limitation is not narrowed to preclude a reasonably broad interpretation that encompasses both multiple and single instructions being sent to “target equipment” as user selected “operation” and that there is no support of Appellants that assert a narrow interpretation. By the current amendment, multiple operations are excluded to distinguish from Shim more clearly. Stenman does not cure the deficiency of Shim. Therefore, independent claims 16, 19, 22, 26, 29, 32, and 36-38 are patentable over Shim and Stenman for at least the above-mentioned reason.

Further, claims 19, 22, 26, 29, 32, 36-38 add distinguishable features over Shim in addition to the feature mentioned above by the second amendment. In Shim, a complete code is stored in advance and transmitted, whereas, in the claimed invention, only part of the second group is stored in advance, the remaining part is generated by a key depression, which is added or coupled to the part that is stored in advance, as stated above. However, the Board states that Appellants do not rely on claimed subject matter that distinctly recite such argued invention subject matter, e.g., user adding any information to stored remote control codes. Since this feature distinguishes from Shim, claims are amended to include such feature. Stenman does not cure the deficiency of Shim. Therefore, claims 19, 22, 26, 29, 32, 36-38 are patentable over Shim and Stenman for at least this reason in addition to the first reason. Accordingly, Applicants

respectfully request withdrawal of the rejection with respect to claims 16, 19, 22, 26, 29, 32, and 36-38 under 35 U.S.C. § 103(a).

Claim 17 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Stenman and Shim and further in view of August et al. (U.S. Patent No.5,671,267) (hereinafter “August”). August is cited as teaching that the group of remote control codes forms recording information for recording of a program. However, August does not cure the deficiency of Stenman and/or Shim. Claim 17 depends on independent claim 16, and, therefore, claim 17 is patentable for at least the same reason as claim 16. Accordingly, Applicants respectfully request withdrawal of the rejection with respect to claim 17 under 35 U.S.C. § 103(a).

Claims 18, 21, 25, 28, 31, and 35 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Stenman and Shim and further in view of Wall. Wall is cited as teaching downloading the various remote control codes associated with the plurality of operation buttons in a one-to one relationship from a server as recited in the claims. However, Wall does not cure the deficiency of Stenman and/or Shim. Claims 18, 21, 25, 28, 31, and 35 depend on independent claims 16, 19, 22, 26, 29 or 32, each of which are patentable over the combination of Stenman and Shim, as discussed above. Therefore, dependent claims 18, 21, 25, 28, 31, and 35 are patentable for at least the same reason as their base claims are patentable.

Claims 20, 23-24, 27, 30, and 33-34 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Stenman and Shim and further in view of August. August does not cure the deficiency of Stenman and/or Shim. Claims 20, 23-24, 27, 30, and 33-34 depend on independent claims 19, 22, 26, 29 or 32, each of which is patentable over Stenman and Shim as discussed above. Therefore, claims 20, 23-24, 27, 30, and 33-34 are patentable for at least the same reason as their base claims are patentable.

Claim 39 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Stenman and Shim and further in view of Wall. Claim 39 is similarly amended as claims 19, 22, 26, 29, 32, 36-38, which are patentable over Stenman and Shim as mentioned above. Wall does not cure the deficiency of Stenman and/or Shim as mentioned above. Therefore, claim 39 is patentable for at least the same reason as claims 19, 22, 26, 29, 32, 36-38.

Claim 40 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Stenman, Shim, Wall, and further in view of Goldstein. Goldstein is cited as teaching to use the same selection for various remote control codes based on a remote control mode. However, Goldstein does not cure the deficiency of Stenman, Shim, and/or Wall. Claim 40 depends on claim 39, and therefore, claim 40 is patentable over Stenman, Shim, Wall, and Goldstein for at least the same reason as claim 39.

## CONCLUSIONS

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, claims 16-40 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Applicants' undersigned attorney at the number indicated below.

Respectfully submitted,



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